

REMARKS

Applicants request reconsideration of the present application in view of this Amendment. Claims 9, 14 and 32-34 are canceled by this Amendment, claims 2, 5-6, 10-12 and 15-16 are amended, and claims 35-45 are added.

Claim 1

Claim 1 recites stocking a predetermined number of sets of foot orthotics, each set having a unique standard arch height. Claim 1 further recites selecting an orthotic from the stocked set for which the standard arch height most closely matches a measured arch height.

The cited reference to Marshall does not disclose or suggest the step of stocking orthotics as claimed. He instead discloses analyzing orthotics to determine coordinates necessary to make a family of molds. The only things Marshall stocks are the molds. Moreover, Marshall does not suggest the claimed step of selecting an orthotic from a stocked set of orthotics. He instead discloses selecting a mold from which to mold a new orthotic for the patient as needed. (col. 14, line 49). Therefore, claim 1 is patentable over the cited prior art.

Claims 2-5 and 29-31

Claims 2-5 and 29-31 depend from claim 1. The limitations that they add to claim 1 distinguish them further from the prior art. Therefore, claims 2-5 and 29-31 also are patentable.

For example, claim 2 includes all of the limitations of claim 1, which is patentable over the prior art as explained above. For that reason alone, claim 2 also is patentable. However, claim 2, as amended, includes the added limitation that the predetermined number of standard sizes of orthotics is "only three". Marshall teaches away from this number by disclosing the number of standard sizes of molds to be "some five hundred and forty or more" (col. 14, line 62). The limitation added by claim 2 thus distinguishes it further from the prior art.

Similarly, claim 5 includes all of the steps of claim 1, plus the added step of pressing the sole against the orthotic while the orthotic is in a shoe in a heat-softened state for the orthotic to conform to the shape of the sole. Marshall does not suggest the orthotic being heat-softened while in a shoe as claimed. Marshall further does not suggest conforming the orthotic to the shape of the sole as claimed. Thus, the step added by claim 5 distinguishes the invention further from the prior art.

Claim 6

Claim 6, as amended, recites engaging a sole of a foot against a thermal imaging device while the foot is "not in a shoe."

This is not disclosed by the cited reference to Dribbon. Dribbon teaches engaging a foot against an imaging device only while the foot is "within the shoes . . . he or she normally wears" (col. 5, line 33) so that the resulting prescribed insert will be applicable to the particular shoes worn by the patient (col. 5, lines 34-36 and col. 3, lines 28-29). This teaches away from the claimed limitation of the foot not being in a shoe during the engaging step. Therefore, claim 6 is patentable over the cited prior art.

Claims 7-8, 10-13 and 15-16

Claims 7-8, 10-13 and 15-16 depend from claim 6. The limitations that they add to claim 6 distinguish them further from the prior art. Therefore, claims 7-8, 10-13 and 15-16 also are patentable.

For example, claim 7 includes all of the limitations of claim 6, which is patentable over the prior art as explained above. For that reason alone, claim 7 also is patentable. However, claim 7 includes the added limitation of determining an arch height from the thermal image. This is not disclosed by the cited reference to Dribbon. The limitation added by claim 7 thus distinguishes it further from the prior art.

Claim 35

New claim 35 discloses determining an arch height of the sole based on a thermal image of the sole.

This is not disclosed by the any of the references, including Dribbon. Dribbon discloses using a thermal image of the sole only for diagnosing foot disorders such as ulcers and infections (col. 1, lines 9-10; col. 4, lines 38-43; and col. 5, lines 14-16). Dribbon does not suggest that arch height can be determined from a thermal image as claimed. In fact, the stated principle behind Dribbon's method -- that damaged tissue generates hot spots (col. 5, lines 19-22) -- is inapplicable to the claimed determination of arch height. Therefore, claim 35 is patentable over the prior art.

Claim 36-39

Claims 36-39 depend from claim 35. The limitations that they add to claim 35 distinguish them further from the prior art. Therefore, claims 36-39 also are patentable.

Claim 40

Claim 40 recites engaging a foot sole against a thermal imaging device. The device includes a thermally sensitive material lying flat over a rigid surface that prevents the material from bending

This is not disclosed or suggested by any of the references, including Dribbon. Dribbon's imaging device lacks the claimed rigid surface and does not, as claimed, prevent the thermally sensitive material from bending. Therefore, claim 40 is patentable over the prior art.

Claims 41-42

Claims 41-42 depend from claim 40. The limitations that they add to claim 40 distinguish them further from the prior art. Therefore, claims 41-42 also are patentable.

Claim 43

Claim 43 recites the step of engaging a sole of a foot against a thermal imaging device to obtain a thermal image of the sole. Before the engaging step, the foot is warmed by an electrical warming device.

The claimed step of pre-warming the sole before engaging it against a thermal imaging device is not disclosed or suggested by any of the references, including Dribbon. In fact, the principle behind Dribbon's method of determining foot disorders would dissuade the skilled person from adding the claimed pre-warming step. That is because Dribbon's method is based on sensing heat naturally generated by damaged tissue (col. 5, lines 19-22). The naturally generated heat would be masked by externally applied heat if the claimed pre-warming step were performed. Therefore, claim 43 is patentable over the prior art.

Claims 44-45

Claims 44-45 depend from claim 43. The limitations that they add to claim 43 distinguish them further from the prior art. Therefore, claims 44-45 also are patentable.

Claim 46

Claim 46 recites a method relating to a thermally sensitive material that is part of a thermal imaging device and is configured to exhibit a change in color with a change in temperature. Claim 40 recites warming the thermally sensitive material to a temperature that is warmer than a sole of a foot and obtaining from the material a thermal image of the sole based on different locations on the material being cooled by the sole to different extents.

None of the references discloses or suggests warming a thermally sensitive material to a temperature that is warmer than the sole as claimed. Furthermore, none of the references discloses or suggests obtaining a thermal image based on the material being cooled by the sole as claimed. Therefore, claim 46 is patentable over the prior art.

Claims 47

Claim 47 depends from claim 46. The limitation that claim 47 adds to claim 46 distinguishes it further from the prior art. Therefore, claim 47 also is patentable.

Claim 48

Claim 48 recites stocking orthotics of different arch heights. Claim 48 further recites selecting, from the stocked orthotics, an orthotic of which the arch height most closely matches a measured arch height.

This is not suggested by any of the reference, including the reference to Marshall. Marshall does not disclose or suggest the step of stocking orthotics as claimed. He instead discloses analyzing orthotics to determine coordinates necessary to make a family of molds. The only things Marshall stocks are the molds. Moreover, Marshall does not suggest the claimed step of selecting an orthotic from stocked orthotics. He instead discloses selecting a mold from which to mold a new orthotic for the patient as needed. (col. 14, line 49). Therefore, claim 48 is patentable over the cited prior art.

Claims 49-51

Claims 49-51 depend from claim 48. The limitations that they add to claim 48 distinguish them further from the prior art. Therefore, claims 49-51 also are patentable.

Claim 52

Claim 52 recites stocking foot orthotics of different arch heights in packages. Each package is imprinted with a reference footprint that is indicative of the arch height of the orthotic in the package.

None of the references discloses or suggests the claimed packages, much less the claimed reference footprints imprinted on the packages. Therefore, claim 52 is patentable over the prior art.

Claims 53-54

Claims 53-54 depend from claim 52. The limitations that they add to claim 52 distinguish them further from the prior art. Therefore, claims 53-54 also are patentable.

The application should now be in condition for allowance, and allowance is requested.

Respectfully submitted,

Mitchell Rose

Mitchell Rose, Patent Agent

Registration No. 47,906

JONES DAY

901 Lakeside Ave.

Cleveland, OH 44114

(216)586-7094

Date: 3/7/05